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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,329	12/31/2003	Edgar Matias	P1282US00	8128
54640	7590	11/23/2005	EXAMINER	
PERRY & PARTNERS 1300 YONGE STREET SUITE 500 TORONTO, ON M4T-1X3 CANADA			PICKETT, JOHN G	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 11/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/748,329

Applicant(s)

MATIAS ET AL.

Examiner

Gregory Pickett

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4/16/04 & 9/20/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 8-11 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear in claim 8 as to whether the limitation regarding the spacer of claim 1 defines additional structure to the spacers of claim 6 (i.e. more than one type of spacer), or whether the claim merely further redefines the spacers of claim 6. As claim 6 already sets forth stackable spacers and claim 7, from which claim 8 depends, sets forth the same structures for the spacer as claim 1, the examiner assumes a redefinition of the spacers of claim 6.

In claims 9-11, the claims present a functional "wherein" statement concerning the spacers of claims 2, 1, and 4 respectively; it is unclear as to whether these structures are included in the claims. Claim 9 is dependent on claim 8, which delimits the structures of claim 2; claim 10 is dependent on claim 7, which delimits the structures of claim 1; and claim 11 is dependent on claim 10, which delimits the structures of claim 4. Since all claimed structures are present without the "wherein... spacer of claim [X]" clause, the examiner will ignore the clause in order to prosecute the claims on their merits.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Cyr (US 5,769,221).

Claims 1 and 2: In figures 3 and 4 of Cyr there is disclosed a shock absorbing spacer **56** comprising an impact absorbing body **59** and an adhesive material **71** on both sides of the body. Insofar as the term “stackable” only requires the ability to stack, Cyr folds into a substantially flat article (see Figure 4) that is inherently “stackable” along its flat major surfaces **57**.

Claim 3: Cyr discloses adhesive **71** as either a hook or loop of a hook-and-loop fastening system (see Col. 7, lines 44-46).

Claim 4: Cyr discloses absorbing body **59** as foam (see Col. 7, lines 6-8).

Claim 5: Cyr discloses spacer **56** having a generally parallelepiped shape (see Figure 3).

3. Claim 6 is rejected under 35 U.S.C. 102(b) as being anticipated by Park (US 6,073,770).

In figure 3, Park discloses a carrying case capable of carrying contents of differing sizes and shapes and comprising a plurality of internal sidewalls (as shown) and cushions **70** inserted between the sidewalls and the contents. As shown in Figure 8, Park anticipates cushions **70** to comprise a plurality of stackable, shock absorbent spacers **88, 90 & 92**.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Park in view of Cyr.

Claim 7: Park, as applied to claim 6 above, discloses the claimed invention except for the adhesive. One of ordinary skill in the art would have recognized that, as presented, the spacers in Figure 8 of Park would be free to move relative to one another.

Cyr, at Figure 13 discloses the use of an adhesive **174** to retain foam spacers in a position to prevent movement. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the spacers of Park with the adhesive of Cyr in order to prevent relative movement between the spacers.

Claim 8: Cyr discloses the adhesive on both sides of the spacer.

Claim 9: Cyr discloses hook-and-loop fasteners (Col. 11, lines 57-61).

Claim 10: both Park (Col. 5, lines 28-47) and Cyr (Col. 7, lines 6-8) disclose foam material.

Claim 11: Park discloses spacers with flat sides and rounded ends instead of parallelepiped shapes.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to form the spacers with a parallelepiped shape because applicant has not disclosed that the parallelepiped shape provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected applicant's invention to perform equally well with either a parallelepiped shape or rounded end shape because applicant so states in paragraph [019] of the instant application.

Therefore, it would have been an obvious matter of design choice to modify the shape of the spacers to obtain the invention as specified in claim 11. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47. A change in aesthetic (ornamental) design generally will not support patentability. *In re Seid*, 73 USPQ 431.


Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Greg Pickett
Examiner
16 November 2005


Mickey Yu
Supervisory Patent Examiner
Group 3700